

Appl. No. 10/071,537  
Response dated June 6, 2008  
Reply to Advisory Action of April 9, 2008

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#### **REMARKS/ARGUMENTS**

By the above amendment, the Applicant has amended the specification to more particularly define the invention without adding any new matter. The specification was amended by inserting text found in Claim 4 as originally submitted in this patent application.

#### **The References And Differences Of The Present Invention Thereover**

Prior to discussing the amended claims, applicant will first discuss the references and the general novelty of the present invention and its unobviousness over the references.

#### **The Rejection Of Claim 1 Under 35 U.S.C 112, First Paragraph, Is Overcome**

The last O.A. rejected Claim 1 indicating that the Examiner found no recitation in the specification for selecting incentives based on past incentives redeemed, for selecting incentives based on past incentives refused, or for selecting incentives based on "a plurality of items first scanned". Applicant requests withdrawal of this rejection because the specification as amended provides the necessary recitations.

Claim 4 of this patent application as originally submitted discloses the description wherein:

"stored data relating to determining an incentive is comprised of a combination of past shopping history of the shopper, a plurality of first products scanned within a product category, a plurality of products purchased with incentives, and/or a plurality of incentives redeemed."

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The specification has been amended by inserting text found in Claim 4 as originally submitted in this patent application so that the specification now more particularly defines the invention without adding any new matter.

The present invention describes the delivery of customized coupons with a very short lifetime, provided dynamically to a shopper while he or she is in the store at the precise moment he or she is making a specific product purchase decision. Given the relevance of the coupons presented and the need to positively confirm the acceptance of an offered incentive before finishing shopping, it would be obvious to anyone skilled in the art that any incentives offered but not redeemed in this particular system would be accurately characterized as "incentives refused". One skilled in the art would also find it obvious that given the new and novel availability to accurately acquire this data that such information would be relevant to forming past shopping behavior metrics for each customer specific to a product class.

**The Rejection Of Claim 1 Under 35 U.S.C 112, Second Paragraph, Is Overcome**

The last O.A. rejected Claim 1 indicating that the Examiner found the recitation of "a plurality of items first scanned" to be unclear and suggested that while one item could be the first scanned within a plurality of items the Examiner did not find it clear how multiple items can be "first" scanned. Additionally it was further unclear how many items may be scanned and still be considered "first". Applicant requests withdrawal of this rejection because the extracted quote in question is part of a longer recitation and makes sense in the complete context.

The rejection suggests that the phrase in question indicates that all items being scanned are being labeled as "first" without any further categorization or distinction of product class. This is not the case. The more complete portion of the claim in question is: "a plurality of items first scanned within a product class on each shopping trip".

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The complete claim is clear given the full context surrounding the extracted text. Furthermore the specification describes the providing of coupons of common type or class:

"the incentive may be a price discount on the particular product the shopper scanned using the PWD, or it may be a price discount on another brand of the same product type (e.g., Brand A potato chips scanned, price discount offered on Brand B potato chips)" (Page 19, paragraph 3)

In light of the full context of the claim and the description of usage in the specification it would be obvious to anyone skilled in the art what a "plurality of items first scanned within a product class on each shopping trip" means in the context of the present invention.

**The Rejection Of Claim 1 On Deaton In View Of Sloane Further In View Of Christensen Is Overcome**

The last O.A. rejected Claim 1 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) further in view of Christensen (U.S. Patent No. 5,710,886). Applicant requests withdrawal of this rejection for the following reasons:

1. Deaton, Sloane, and Christensen do not teach the unique aspects described by the present invention.
2. There is explicit teaching away from such combination.
3. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
4. The references themselves teach away by implication from the suggested

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combination.

5. Even if Deaton, Sloane and Christensen were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 1.
6. The novel features of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references.
7. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, and Christensen.
8. Thus Claim 1 is allowable.

**Deaton, Sloane, And Christensen Do Not Teach The Unique Aspects Described By The Present Invention**

Sloane teaches a method that offers incentives to a shopper which are preloaded from the retailer/manufacturer's computers into a controller that determines if a consumer will receive notification of an incentive being offered. The loading of these incentives happens prior to the shopper scanning a product and is in no way customized to the behavior of each shopper and the concerns of each manufacturer. Sloane fails to teach a system for delivering shopping incentives individually customized to influence each customer.

Deaton teaches a system for delivering incentives based on current purchases (scanned at point of sale) and customer past purchase history. The past purchase history described by Deaton is limited to only tracking the items purchased in previous shopping trips. When current purchase data is used to establish an incentive, i.e. as captured at the point-of-sale register as described by Deaton, the incentive is inherently less effective because the information used to establish the incentive is limited to what has been purchased in the past and cannot utilize other past shopping behavior metrics such as past incentives refused, or items first scanned within a product category on each

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shopping trip. Additionally, Deaton describes an inferior system that offers incentives at the point of sale, well after the decision making moment has passed. In contrast, the present invention offers targeted incentives while the shopper is in the aisle, standing in front of the competing products in the aisle, at the precise moment the purchase decision is being made.

Additionally, the manufacturer controlled incentive engines described by Deaton are incompatible with the data that would be provided by a wireless system as described by Sloane. Deaton specifically describes a system that is designed to provide items purchased and prices paid to the manufacturer controlled incentive engines. However, if one were to combine the wireless handheld scanner described by Sloane with the manufacturer controlled incentive engines described by Deaton, the incentive engines would receive data scanned while the person is shopping and has not yet finalized a purchase decision. The manufacturer controlled incentive engines described by Deaton would not expect nor would they be able to handle the kinds of data that would be provided by such a system. The references not only do not teach the unique aspects described by the present invention, the references teach away from combination. The references would only be seen as combinable to arrive at the present invention with impermissible hindsight.

It has been suggested that incentives offered by Deaton take into account all current purchases regardless of their order of scanning, and thus reads on items that are "first" scanned or "last" scanned. This reading does not have any bearing on the present invention as the "first scanned" distinction as read in Deaton is not the same nor does it offer the same benefits as those described by the present invention. In Deaton there is no distinction between "products scanned" and "products purchased" as they are one and the same, therefore Deaton offers no inherent benefit to tracking the "first" product scanned. In comparison, numerous items are identified as "first scanned within

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a product category on a shopping trip" by the present invention. These scanning events happens prior to the point of sale register while the customer is still shopping, and more specifically happen while the shopper is in the aisle and standing in front of the array of competing products in the aisle at the precise moment the purchase decision is being made. The present invention describes a system whereby the "first" product scanned indicates interest in a specific product within a specific product category. In this case a "first scan within a product category" triggers a cascade of events as described in the present invention that provides a selection of customized incentives from competing manufacturers to be presented on the customer's handheld personal wireless device (PWD).

As an example of the customer's experience using the present invention, scanning potato chips from "Brand A" would cause potato chip coupons to be offered from "Brand A" and "Brand B". Allowing that the "Brand B" offering was the most persuasive, the customer would select the "Brand B" incentive on his or her PWD, place the "Brand A" package back on the shelf, and continue to purchase the "Brand B" bag of chips. This purchase selection will be positively confirmed at the checkout when the "Brand B" chips are purchased and the related incentive is redeemed. This example also shows how the present invention can uniquely make the positive distinction between an incentive that has been "rejected" as well as the simpler "redeemed". Unlike Deaton, the present invention would be aware that the customer has been persuaded by the incentive offered compelling him or her to put the item first scanned in that product category back on the shelf to instead purchase a different product from the same product category.

Because the system described by Deaton offers your typical post-purchase printed coupons delivered via the point of sale register, the incentives created by that system are subject to the common problems of being frequently lost, expiring, or being simply

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forgotten. Another problem for the Deaton system is time to redemption. Printed coupons typically have expiration dates that measure in weeks and months (as compared to hours in the present invention). This means that while the coupons offered by Deaton may be dynamic, they cannot provide the benefit of offering manufacturers budgetary flexibility. Printed coupons, such as Deaton provides, leave the manufacturer unsure if the coupon offered will be redeemed or not for an extended period of time. This uncertainty requires the manufacturer to tie up budgetary funds to cover the estimated maximum redemption rate thereby limiting the flexibility needed to reallocate those funds to other more successful incentive programs or other better methods of marketing. The present invention purposefully remedies this problem by creating incentives that are offered while the shopper is in the aisle and standing in front of the array of competing products in the aisle at the precise moment the purchase decision is being made and furthermore by offering incentives that have a lifetime measured in hours. The ability of manufacturers to rapidly assess the success of each incentive and to quickly allocate budgetary funds to those incentive programs that are most successful while reducing the funding of those that are not is another distinct benefit of the present invention not offered by the prior art.

Christensen teaches a system whereby a customer loads a computer program onto his or her personal computer, registers said application by calling an 800 number whereby the user then provides detailed demographic information, and then is able to search the application for any coupons he or she might be interested in. Once a customer locates a coupon he or she would print the coupon on a printer whereby the coupon would have a unique household ID printed on it. At this point the coupon is no different in usage than a common printed paper coupon and would be subject to being lost, expiring, or being simply forgotten.

Christensen describes that the household ID printed on the coupon would allow his system to determine "exactly which consumers purchased which particular products

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and from which retailers" (Column 10, Lines 48-50). Later Christensen teaches that based on the coupons redeemed his system can emphasize and de-emphasize whole categories of coupons, but he does not suggest the ability to establish that any specific incentive has been explicitly rejected.

"If the consumer redeems no coupons from a given category, such coupons may be de-emphasized until the consumer's buying habits change. For example, if a given consumer uses no baby or child product coupons, such categories may be de-emphasized. If a consumer starts redeeming such coupons, then it may be inferred that the consumer has started a family, and coupons targeted toward family needs may then be included in a consumer's subsequent mailings."  
(Column 10, Lines 4-12)

Coupons produced by the Christensen system are not inherently superior to standard coupons in terms usage and redemption. Christensen does not assert that if a specific coupon loaded in his application is never redeemed that this should infer that the coupon has been rejected. Even in scenarios where a coupon has been *confirmed as printed* and then not redeemed Christensen warns against presuming that as accurate enough to infer that the printed incentive has been rejected. He explicitly teaches against making such an assumption.

"Coupon printing information may be uploaded via such on-line services to provide marketing data, however, it is believed that such printing data may not be as accurate as redemption data, as redemption data indicates a definite sale of a product." (Column 11, Lines 22-26)

The present invention is novel and produces unexpected results by going beyond simple past purchase history. To establish precise shopping behavior metrics the present invention considers the details of past items first scanned within a product class and, because of the timely immediacy of incentives offered in the store at the moment a



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purchase decision is being made, the present invention can reasonably determine past incentives offered but refused, as well as past incentives ultimately redeemed.

Neither Deaton nor Sloane describe tracking other past shopping behavior metrics such as past incentives redeemed, past incentives refused, or items first scanned within a product category on each shopping trip. The purchase history described by Deaton and Sloane falls far short of the metrics tracked by the present invention. While Christensen does describe printing a household ID onto each coupon it is not suggested that this mechanism would provide a metric for measuring incentives refused just because they were not printed and accordingly not redeemed. To reinforce this point Christensen even teaches against making such assumptions of incentive rejection as inaccurate even in the event a coupon is printed and still not redeemed. Given that Christensen teaches against the ability to infer coupon rejection in the event that a coupon is printed and then not redeemed, it is clear that in the event a coupon has not been printed and not redeemed that this would be an even more unreliable indicator of incentive rejection.

Neither Deaton nor Sloane nor Christensen describe capturing this complex data and in some cases they actively teach away from it. The present invention can use this unique collection of data to establish customer behavior metrics for each individual shopper that establish the efficacy of past incentives and their ability get each consumer to abandon (or retain) their first product choice. It is only with impermissible hindsight that one would combine Deaton, Sloane and Christensen to arrive at the present invention.

#### **There Is Explicit Teaching Away From Such Combination**

Sloane explicitly teaches away from combining or integrating with any system that distributes coupons with certain key attributes. As explained in Sloane:

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"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the method of dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic system, accurately describe those found in Deaton's. Sloane describes his system as superior and inherently incompatible with one such as that described by Deaton.

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination as found in Sloane. It is only with impermissible hindsight that one would think to combine Deaton, Sloane and Christensen to arrive at the present invention.

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**References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.**

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

*References teach away from combination.* As indicated in the O.A., "Deaton determines incentives based on current purchases (scanned at point of sale)". Sloane however describes a system that is used to scan products while still shopping, specifically identified as "Point-of-Purchase" whereby products are only selected and their ultimate purchase remains in question and open to influence. Sloane even discusses the distinction between the term point-of-sale as used by Deaton.

"Promotional offers and coupon distribution for competitive products serve to alter the consumer's future purchasing behavior. The most widely used example of this involves coupons printed and distributed at the supermarket or retailer checkout counter based on the items that are purchased (i.e., point-of-sale). These issued coupons must be used on a subsequent trip to the supermarket or retail establishment." (Column 1, Lines 44-50)

As described in Sloane products would not be purchased until the consumer returns the portable bar code scanner to the scanner center. Since the scanner would now be returned and no longer in the possession of the consumer all incentives would again have to be delivered after the shopping is completed as described in Deaton.

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Additionally, the manufacturer controlled incentive engines described by Deaton are incompatible with the data that would be provided by a wireless system as described by Sloane. Deaton specifically describes a system that is designed to provide items purchased and prices paid to the manufacturer controlled incentive engines. However, if one were to combine the wireless handheld scanner described by Sloane with the manufacturer controlled incentive engines described by Deaton, the incentive engines would receive data scanned while the person is shopping and has not yet finalized a purchase decision. The manufacturer controlled incentive engines described by Deaton would not expect nor would they be able to handle the kinds of data that would be provided by such a system. The references teach away from each other and would only be seen as combinable to arrive at the present invention with impermissible hindsight.

*References each capture information about a customer's purchase at distinctly different moments in the shopping process.* While Sloane allows for the capture of product UPC codes during the product selection phase, Deaton instead captures all product information at the final moment when a purchase is being made. Christensen can only capture information about incentive redemption days or weeks later during the coupon reconciliation process at a coupon redemption clearinghouse.

This time of data acquisition is important in the present invention and further renders the combination of the references incompatible. The manufacturer controlled incentive engines described by Deaton describes a system that relies on only passing the items purchased and prices paid to the manufacturer controlled incentive engines. If one were to combine Sloane and Deaton a customer using a wireless scanner while shopping would inevitably be scan a product they were only contemplating purchasing and would then change their mind and put back on the shelf. In the present invention and the references cited, data acquired at different moments in the process will result in substantial changes to the nature of the data being captured itself. Such a difference in

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time additionally changes as the actionable nature of such data. Information being sent from a hand held device as described in Sloane to manufacturer incentive engines as described by Deaton would not work.

Christensen doesn't suggest combination with either Deaton or Sloane since all the relevant information in this system is captured weeks later during the coupon reconciliation process at a clearinghouse.

Given the discrepancies in when data is captured these references, by implication, each teach away from combining itself with the other. Since they teach away from each other it would not be logical to combine them without the use of impermissible hindsight.

*References have different incompatible time frames for providing customer incentive redemption information to the manufacturer.* Deaton describes a system whereby coupons are printed at the register after products have been scanned and purchased. Printing incentives at this stage means that any coupons used will not be redeemed for an indeterminate amount of time, that beginning on the date the coupons are issued at the checkout counter, adding the time until the customer goes shopping again and redeems said coupon. Accordingly, manufacturers will also be unable to receive any data pertaining to the redemption of offered incentives for an indeterminate amount of time.

Christensen describes printing a household ID onto each incentive. With the system described by Christensen incentive redemption can only be captured after an indeterminate time starting at the date the manufacturer issues the incentive, add the time until the incentive is loaded onto the customers computer, adding the time until the customer prints the coupon, adding the time until the customer goes shopping and

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redeems the coupon, and adding the time until the coupon arrives at the coupon clearinghouse to be scanned.

Sloane describes a system that provides static incentives to a customer based upon searching a preloaded non-dynamic collection of incentives on a remote server or database. However Sloane does not describe notifying manufacturers of coupon redemption status. The system as described by Sloane indicates that a printed coupon may be generated, but said coupon is not described as having any means of identifying the customer so such information can *never* be captured.

The discrepancies between the capture of incentive redemption information and the time it takes to do so (if at all) illustrates how each reference teaches away from combining itself with any of the others. Since they teach away from each other it would not be logical to combine them without the use of impermissible hindsight.

*References have completely different systems for determining the incentives that should be offered to a customer.* Sloane and Christensen teach systems where incentives are selected from among those that have been preloaded into a computer server or database. Deaton describes a system that delivers shopping incentives which are generated by a plurality of independently competing manufacturer controlled dynamic offer engines that customize each incentive to meet manufacturer objectives. Given the discrepancies in the systems for determining the incentives to offer these references teach away from each other by implication and it would not be logical to combine them without the use of impermissible hindsight.

*References have completely different means of delivering incentives to customers.* Sloane teaches displaying incentives directly on a wireless device in the store while shopping. Deaton teaches a system that offers custom incentives printed at the register

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after the purchase is complete, delivered via email some time after the shopping is done, or alternatively printed at a kiosk in the store during the next shopping visit. Christensen teaches loading a computer program onto a personal computer, registering said application by calling an 800 number, providing detailed demographic information, searching the application for any coupons of interest, and then printing any coupons found. Given the discrepancies in the systems for delivering incentives these references teach away from each other by implication and it would not be logical to combine them without the use of impermissible hindsight.

*References have dramatically different descriptions regarding integration with traditional Point of Sale systems.* Deaton teaches a system that is very tightly integrated with the traditional existing store POS system with a cash register and scanner at the end of a check out isle. As the Deaton system depends on data collected at the point of purchase and not during the shopping process it requires this tightly integrated configuration. Sloane, on the other hand, describes a system that is designed to replace the traditional POS system seen today and instead teaches a system with consumer self directed checkout that maintains a running total of purchases as a customer shops throughout the store. Christensen does not integrate with the POS system but instead prints a coupon at home and allows the POS system to remain largely intact. However, given the household identifying ID, it is apparent that Christensen would require additional hardware, software, or both to be installed at all coupon clearing houses to make the scanning and sorting of their target coupons possible. Given the discrepancies in utilization of traditional POS systems versus cart focused consumer directed checkout these references teach away from each other by implication.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the

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references are not sufficient to render the claims prima facie obvious and it would not be logical to combine them without the use of impermissible hindsight.

**Even If Deaton, Sloane, And Christensen Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 1.**

Even if the combination of Deaton, Sloane, and Christensen were legally justified, Claim 1 would still have novel and unobvious features over the proposed combination. In other words applicant's invention as defined by Claim 1 comprises much more than starting with Deaton, adding the wireless scanning device as described in Sloane, and further adding the household ID as described by Christensen. Those features, more fully described in Claim 1, include a system for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**These Novel Features Of Claim 1 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.**

Also applicant submits that the novel features of claim 1 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton and Christensen.

The new and unexpected results, more fully described in Claim 1, include a system for delivering shopping incentives individually customized to influence each customer for



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products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane And Christensen.**

The novel features of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Christensen without the use of impermissible hindsight.

**Dependent Claims 2, 3, 5, 7, And 8 Are A Fortiori Patentable Over Deaton, In View Of Sloane, And Further In View Of Christensen**

The last O.A. rejected dependent Claims 2-5, 7, and 8 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211), and further in view of Christensen (U.S. Patent No. 5,710,886). Original dependent claims 2-5, 7, and 8 incorporate all the subject matter of Claim 1 and add additional subject matter, which makes them a fortiori and independently patentable over these references.

**The Rejection Of Dependent Claim 4 In View Of Deaton In View Of Sloane In View Of Christensen And Further In View Of Anttila Is Overcome**

Dependent claim 4 had already been cancelled in a previous amendment. Applicant only mentions this in the interest of completeness and suspects that the rejection of

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claim 4 was just a typographical oversight and has no bearing on the consideration of patentability over Deaton, Sloane, or Christensen.

**The Rejection Of Dependent Claim 6 In View Of Deaton In View Of Sloane In View of Christensen And Further In View Of Anttilla Is Overcome**

The last O.A. rejected dependent Claim 6 on the combined teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211), in view of Christensen (U.S. Patent No. 5,710,886) and further in view of Anttilla (U.S. Patent No. 6,862,575). Applicant requests reconsideration and allowance over this rejection for the following reasons:

1. Claim 1 already overcomes Deaton, Sloane, and Christensen
2. There is explicit teaching away from such combination
3. There is no suggestion to combine these references.
4. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
5. The references themselves teach away by implication from the suggested combination.
6. Even if the references were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 6.
7. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Anttilla.

**Claim 1 Already Overcomes Deaton, Sloane, And Christensen**

Applicant submits that as Claim 1 already overcomes Deaton, Sloane, and Christensen the addition of a wireless device as generating a bar code to be scanned by a point of

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sale, as suggested by Anttilla, brings forth the same arguments made above against combining references.

**There Is Explicit Teaching Away From Such Combination**

Sloane explicitly teaches away from combining or integrating with any system that distributes coupons with certain key attributes. As explained in Sloane:

"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the system for dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic system, accurately describe those found in Deaton's. Sloane describes its system to be superior and inherently incompatible with one such as that described by Deaton.

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Because Christensen describes a system that hinges on printing coupons from a home computer it is reasonable to imagine that someone considering the dynamic bar code rendering patent Anttilla would see these two patents strongly teaching away from each other.

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination without the benefit of impermissible hindsight.

**There Is No Suggestion To Combine These References**

As noted above, there is ample case law that discusses impermissible hindsight vision afforded by the claimed invention.

In the present case, there is no reason given in the last O.A. to support the proposed combination. The original dependent claim 6 incorporates all the subject matter of claim 1 and adds additional subject matter. Applicant submits that since claim 1 overcomes Deaton, Sloane, and Christensen claim 6 is already a fortiori and independently patentable over Deaton in view of Sloane, in view of Christensen, and further in view of Anttilla. That all noted references teach varied methods for providing a discount offer is not sufficient to gratuitously and selectively substitute parts of one reference for parts of other references in order to meet applicant's novel claimed combination, as exemplified starting with Sloane's wireless scanner, by adding Deaton's definition of independently competing manufacturer controlled dynamic offer engines, by then adding the household ID printed on the Christensen coupons, and finally adding Anttilla's scannable bar code display. This impossible combination exemplifies impermissible hindsight by taking the minutest of attributes from varied and incompatible prior art patents and artificially asserting that one could force them

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together. There is no suggestion in these references that would lead one of having ordinary skill in the art would think to put them together.

**References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.**

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Sloane, Deaton and Christensen already teach strongly away from each other (as noted above). The addition of the feature from Anttilla does not overcome the teaching away of Sloane and Deaton and further teaches away from addition to Sloane. The integration of Deaton and Sloane as suggested by the O.A., would eliminate the traditional POS system as described in Deaton and instead would create a system with an integrated hand held wireless customer self actuated POS system. It would be even more illogical to add Christensen to that whereby the consumer searches for patents loaded on his or her pc and prints them. It would then be additionally illogical to add a scannable barcode display to the wireless device of this resultant system since there would be no traditional POS system to scan the barcodes on said display. This lack of logical combination additionally teaches away from such a combination.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious and would only make sense with the benefit of impermissible hindsight vision afforded by the claimed invention.

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**Even If Deaton, Sloane, Christensen, And Anttilla Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 6**

Even if the combination of Deaton, Sloane, Christensen, and Anttilla were legally justified, claim 6 incorporating all the subject matter of claim 1 would still have novel (and unobvious) features over the proposed combination. In other words, applicant's invention as defined by Claim 6 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane, then adding the household ID from Christensen, and then adding a scannable bar code display from Anttilla.

The new and unexpected results, more fully described in Claim 1, include a system for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**These Novel Features Of Claim 6 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.**

Also applicant submits that the novel features of claim 6 incorporating all the subject matter of claim 1 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton, and Anttilla.

The new and unexpected results, more fully described in Claim 1, include a system for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a

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plurality of Independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane, Christensen, And Anttilla.**

The novel features of claim 6 incorporate all the subject matter of claim 1 produce new and unexpected results, as described above, and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, Christensen, and Anttilla and would have only make sense with the benefit of impermissible hindsight vision afforded by the claimed invention.

**The Rejection Of Claim 9 Under 35 U.S.C 112, First Paragraph, Is Overcome**

The last O.A. rejected Claim 9 indicating that the Examiner found no recitation in the specification for selecting incentives based on past incentives redeemed, for selecting incentives based on past incentives refused, or for selecting incentives based on "a plurality of items first scanned". Applicant requests withdrawal of this rejection because the specification as amended provides the necessary recitations.

Claim 4 of this patent application as originally submitted discloses the description wherein:

"stored data relating to determining an incentive is comprised of a combination of past shopping history of the shopper, a plurality of first products scanned within a product category, a plurality of products purchased with incentives,

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and/or a plurality of incentives redeemed.”

The specification has been amended by inserting text found in Claim 4 as originally submitted in this patent application so that the specification now more particularly defines the invention without adding any new matter.

The present invention describes the delivery of customized coupons with a very short lifetime, provided dynamically to a shopper while he or she is in the store at the precise moment he or she is making a specific product purchase decision. Given the relevance of the coupons presented and the need to positively confirm the acceptance of an offered incentive before finishing shopping, it would be obvious to anyone skilled in the art that any incentives offered but not redeemed in this particular method would be accurately characterized as “incentives refused”. One skilled in the art would also find it obvious that given the new and novel availability to accurately acquire this data that such information would be relevant to forming past shopping behavior metrics for each customer specific to a product class.

**The Rejection Of Claim 9 Under 35 U.S.C 112, Second Paragraph, Is Overcome**

The last O.A. rejected Claim 9 indicating that the Examiner found the recitation of “a plurality of items first scanned” to be unclear and suggested that while one item could be the first scanned within a plurality of items the Examiner did not find it clear how multiple items can be “first” scanned. Additionally it was further unclear how many items may be scanned and still be considered “first”. Applicant requests withdrawal of this rejection because the extracted quote in question is part of a longer recitation and makes sense in the complete context.

The rejection suggests that the phrase in question indicates that all items being scanned are being labeled as “first” without any further categorization or distinction of product



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class. This is not the case. The more complete portion of the claim in question is: "a plurality of items first scanned within a product class on each shopping trip".

The complete claim is clear given the full context surrounding the extracted text. Furthermore the specification describes the providing of coupons of common type or class:

"the incentive may be a price discount on the particular product the shopper scanned using the PWD, or it may be a price discount on another brand of the same product type (e.g., Brand A potato chips scanned, price discount offered on Brand B potato chips)" (Page 19, paragraph 3)

In light of the full context of the claim and the description of usage in the specification it would be obvious to anyone skilled in the art what a "plurality of items first scanned within a product class on each shopping trip" means in the context of the present invention.

**The Rejection Of Claim 9 On Deaton In View Of Sloane Further In View Of Christensen Is Overcome**

The last O.A. rejected Claim 9 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) further in view of Christensen (U.S. Patent No. 5,710,886). Applicant requests withdrawal of this rejection for the following reasons:

9. Deaton, Sloane, and Christensen do not teach the unique aspects described by the present invention.
10. There is explicit teaching away from such combination.
11. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be

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logical to combine them.

12. The references themselves teach away by implication from the suggested combination.
13. Even if Deaton, Sloane and Christensen were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 9.
14. The novel features of claim 9 produce new and unexpected results and hence are unobvious and patentable over these references.
15. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, and Christensen.
16. Thus Claim 9 is allowable.

**Deaton, Sloane, And Christensen Do Not Teach The Unique Aspects Described By The Present Invention**

Sloane teaches a method that offers incentives to a shopper which are preloaded from the retailer/manufacturer's computers into a controller that determines if a consumer will receive notification of an incentive being offered. The loading of these incentives happens prior to the shopper scanning a product and is in no way customized to the behavior of each shopper and the concerns of each manufacturer. Sloane fails to teach a method for delivering shopping incentives individually customized to influence each customer.

Deaton teaches a method for delivering incentives based on current purchases (scanned at point of sale) and customer past purchase history. The past purchase history described by Deaton is limited to only tracking the items purchased in previous shopping trips. When current purchase data is used to establish an incentive, i.e. as captured at the point-of-sale register as described by Deaton, the incentive is inherently less effective because the information used to establish the incentive is limited to what

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has been purchased in the past and cannot utilize other past shopping behavior metrics such as past incentives refused, or items first scanned within a product category on each shopping trip. Additionally, Deaton describes an inferior method that offers incentives at the point of sale, well after the decision making moment has passed. In contrast, the present invention offers targeted incentives while the shopper is in the aisle, standing in front of the competing products in the aisle, at the precise moment the purchase decision is being made.

Additionally, the manufacturer controlled incentive engines described by Deaton are incompatible with the data that would be provided by a wireless method as described by Sloane. Deaton specifically describes a method that is designed to provide items purchased and prices paid to the manufacturer controlled incentive engines. However, if one were to combine the wireless handheld scanner described by Sloane with the manufacturer controlled incentive engines described by Deaton, the incentive engines would receive data scanned while the person is shopping and has not yet finalized a purchase decision. The manufacturer controlled incentive engines described by Deaton would not expect nor would they be able to handle the kinds of data that would be provided by such a method. The references not only do not teach the unique aspects described by the present invention, the references teach away from combination. The references would only be seen as combinable to arrive at the present invention with impermissible hindsight.

It has been suggested that incentives offered by Deaton take into account all current purchases regardless of their order of scanning, and thus reads on items that are "first" scanned or "last" scanned. This reading does not have any bearing on the present invention as the "first scanned" distinction as read in Deaton is not the same nor does it offer the same benefits as those described by the present invention. In Deaton there is no distinction between "products scanned" and "products purchased" as they are one

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and the same, therefore Deaton offers no inherent benefit to tracking the "first" product scanned. In comparison, numerous items are identified as "first scanned within a product category on a shopping trip" by the present invention. These scanning events happens prior to the point of sale register while the customer is still shopping, and more specifically happen while the shopper is in the aisle and standing in front of the array of competing products in the aisle at the precise moment the purchase decision is being made. The present invention describes a method whereby the "first" product scanned indicates interest in a specific product within a specific product category. In this case a "first scan within a product category" triggers a cascade of events as described in the present invention that provides a selection of customized incentives from competing manufacturers to be presented on the customer's handheld personal wireless device (PWD).

As an example of the customer's experience using the present invention, scanning potato chips from "Brand A" would cause potato chip coupons to be offered from "Brand A" and "Brand B". Allowing that the "Brand B" offering was the most persuasive, the customer would select the "Brand B" incentive on his or her PWD, place the "Brand A" package back on the shelf, and continue to purchase the "Brand B" bag of chips. This purchase selection will be positively confirmed at the checkout when the "Brand B" chips are purchased and the related incentive is redeemed. This example also shows how the present invention can uniquely make the positive distinction between an incentive that has been "rejected" as well as the simpler "redeemed". Unlike Deaton, the present invention would be aware that the customer has been persuaded by the incentive offered compelling him or her to put the item first scanned in that product category back on the shelf to instead purchase a different product from the same product category.

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Because the method described by Deaton offers your typical post-purchase printed coupons delivered via the point of sale register, the incentives created by that method are subject to the common problems of being frequently lost, expiring, or being simply forgotten. Another problem for the Deaton method is time to redemption. Printed coupons typically have expiration dates that measure in weeks and months (as compared to hours in the present invention). This means that while the coupons offered by Deaton may be dynamic, they cannot provide the benefit of offering manufacturers budgetary flexibility. Printed coupons, such as Deaton provides, leave the manufacturer unsure if the coupon offered will be redeemed or not for an extended period of time. This uncertainty requires the manufacturer to tie up budgetary funds to cover the estimated maximum redemption rate thereby limiting the flexibility needed to reallocate those funds to other more successful incentive programs or other better methods of marketing. The present invention purposefully remedies this problem by creating incentives that are offered while the shopper is in the aisle and standing in front of the array of competing products in the aisle at the precise moment the purchase decision is being made and furthermore by offering incentives that have a lifetime measured in hours. The ability of manufacturers to rapidly assess the success of each incentive and to quickly allocate budgetary funds to those incentive programs that are most successful while reducing the funding of those that are not is another distinct benefit of the present invention not offered by the prior art.

Christensen teaches a method whereby a customer loads a computer program onto his or her personal computer, registers said application by calling an 800 number whereby the user then provides detailed demographic information, and then is able to search the application for any coupons he or she might be interested in. Once a customer locates a coupon he or she would print the coupon on a printer whereby the coupon would have a unique household ID printed on it. At this point the coupon is no different in usage

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than a common printed paper coupon and would be subject to being lost, expiring, or being simply forgotten.

Christensen describes that the household ID printed on the coupon would allow his method to determine "exactly which consumers purchased which particular products and from which retailers" (Column 10, Lines 48-50). Later Christensen teaches that based on the coupons redeemed his method can emphasize and de-emphasize whole categories of coupons, but he does not suggest the ability to establish that any specific incentive has been explicitly rejected.

"If the consumer redeems no coupons from a given category, such coupons may be de-emphasized until the consumer's buying habits change. For example, if a given consumer uses no baby or child product coupons, such categories may be de-emphasized. If a consumer starts redeeming such coupons, then it may be inferred that the consumer has started a family, and coupons targeted toward family needs may then be included in a consumer's subsequent mailings."  
(Column 10, Lines 4-12)

Coupons produced by the Christensen method are not inherently superior to standard coupons in terms usage and redemption. Christensen does not assert that if a specific coupon loaded in his application is never redeemed that this should infer that the coupon has been rejected. Even in scenarios where a coupon has been *confirmed as printed* and then not redeemed Christensen warns against presuming that as accurate enough to infer that the printed incentive has been rejected. He explicitly teaches against making such an assumption.

"Coupon printing information may be uploaded via such on-line services to provide marketing data, however, it is believed that such printing data may not be as accurate as redemption data, as redemption data indicates a definite sale of a product." (Column 11, Lines 22-26)

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The present invention is novel and produces unexpected results by going beyond simple past purchase history. To establish precise shopping behavior metrics the present invention considers the details of past items first scanned within a product class and, because of the timely immediacy of incentives offered in the store at the moment a purchase decision is being made, the present invention can reasonably determine past incentives offered but refused, as well as past incentives ultimately redeemed.

Neither Deaton nor Sloane describe tracking other past shopping behavior metrics such as past incentives redeemed, past incentives refused, or items first scanned within a product category on each shopping trip. The purchase history described by Deaton and Sloane falls far short of the metrics tracked by the present invention. While Christensen does describe printing a household ID onto each coupon it is not suggested that this mechanism would provide a metric for measuring incentives refused just because they were not printed and accordingly not redeemed. To reinforce this point Christensen even teaches against making such assumptions of incentive rejection as inaccurate even in the event a coupon is printed and still not redeemed. Given that Christensen teaches against the ability to infer coupon rejection in the event that a coupon is printed and then not redeemed, it is clear that in the event a coupon has not been printed and not redeemed that this would be an even more unreliable indicator of incentive rejection.

Neither Deaton nor Sloane nor Christensen describe capturing this complex data and in some cases they actively teach away from it. The present invention can use this unique collection of data to establish customer behavior metrics for each individual shopper that establish the efficacy of past incentives and their ability get each consumer to abandon (or retain) their first product choice. It is only with impermissible hindsight that one would combine Deaton, Sloane and Christensen to arrive at the present invention.

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**There Is Explicit Teaching Away From Such Combination**

Sloane explicitly teaches away from combining or integrating with any method that distributes coupons with certain key attributes. As explained in Sloane:

"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the method of dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic method, accurately describe those found in Deaton's. Sloane describes his method as superior and inherently incompatible with one such as that described by Deaton.

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination as found



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In Sloane. It is only with impermissible hindsight that one would think to combine Deaton, Sloane and Christensen to arrive at the present invention.

**References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.**

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

*References teach away from combination.* As indicated in the O.A., "Deaton determines incentives based on current purchases (scanned at point of sale)". Sloane however describes a method that is used to scan products while still shopping, specifically identified as "Point-of-Purchase" whereby products are only selected and their ultimate purchase remains in question and open to influence. Sloane even discusses the distinction between the term point-of-sale as used by Deaton.

"Promotional offers and coupon distribution for competitive products serve to alter the consumer's future purchasing behavior. The most widely used example of this involves coupons printed and distributed at the supermarket or retailer checkout counter based on the items that are purchased (i.e., point-of-sale). These issued coupons must be used on a subsequent trip to the supermarket or retail establishment." (Column 1, Lines 44-50)

As described in Sloane products would not be purchased until the consumer returns the portable bar code scanner to the scanner center. Since the scanner would now be

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returned and no longer in the possession of the consumer all incentives would again have to be delivered after the shopping is completed as described in Deaton.

Additionally, the manufacturer controlled incentive engines described by Deaton are incompatible with the data that would be provided by a wireless method as described by Sloane. Deaton specifically describes a method that is designed to provide items purchased and prices paid to the manufacturer controlled incentive engines. However, if one were to combine the wireless handheld scanner described by Sloane with the manufacturer controlled incentive engines described by Deaton, the incentive engines would receive data scanned while the person is shopping and has not yet finalized a purchase decision. The manufacturer controlled incentive engines described by Deaton would not expect nor would they be able to handle the kinds of data that would be provided by such a method. The references teach away from each other and would only be seen as combinable to arrive at the present invention with impermissible hindsight.

*References each capture information about a customer's purchase at distinctly different moments in the shopping process.* While Sloane allows for the capture of product UPC codes during the product selection phase, Deaton instead captures all product information at the final moment when a purchase is being made. Christensen can only capture information about incentive redemption days or weeks later during the coupon reconciliation process at a coupon redemption clearinghouse.

This time of data acquisition is important in the present invention and further renders the combination of the references incompatible. The manufacturer controlled incentive engines described by Deaton describes a method that relies on only passing the items purchased and prices paid to the manufacturer controlled incentive engines. If one were to combine Sloane and Deaton a customer using a wireless scanner while shopping would inevitably be scan a product they were only contemplating purchasing and would

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then change their mind and put back on the shelf. In the present invention and the references cited, data acquired at different moments in the process will result in substantial changes to the nature of the data being captured itself. Such a difference in time additionally changes as the actionable nature of such data. Information being sent from a hand held device as described in Sloane to manufacturer incentive engines as described by Deaton would not work.

Christensen doesn't suggest combination with either Deaton or Sloane since all the relevant information in this method is captured weeks later during the coupon reconciliation process at a clearinghouse.

Given the discrepancies in when data is captured these references, by implication, each teach away from combining itself with the other. Since they teach away from each other it would not be logical to combine them without the use of impermissible hindsight.

*References have different incompatible time frames for providing customer incentive redemption information to the manufacturer.* Deaton describes a method whereby coupons are printed at the register after products have been scanned and purchased. Printing incentives at this stage means that any coupons used will not be redeemed for an indeterminate amount of time, that beginning on the date the coupons are issued at the checkout counter, adding the time until the customer goes shopping again and redeems said coupon. Accordingly, manufacturers will also be unable to receive any data pertaining to the redemption of offered incentives for an indeterminate amount of time.

Christensen describes printing a household ID onto each incentive. With the method described by Christensen incentive redemption can only be captured after an

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Indeterminate time starting at the date the manufacturer issues the incentive, add the time until the incentive is loaded onto the customers computer, adding the time until the customer prints the coupon, adding the time until the customer goes shopping and redeems the coupon, and adding the time until the coupon arrives at the coupon clearinghouse to be scanned.

Sloan describes a method that provides static incentives to a customer based upon searching a preloaded non-dynamic collection of incentives on a remote server or database. However Sloane does not describe notifying manufacturers of coupon redemption status. The method as described by Sloane indicates that a printed coupon may be generated, but said coupon is not described as having any means of identifying the customer so such information can *never* be captured.

The discrepancies between the capture of incentive redemption information and the time it takes to do so (if at all) illustrates how each reference teaches away from combining itself with any of the others. Since they teach away from each other it would not be logical to combine them without the use of impermissible hindsight.

*References have completely different methods for determining the incentives that should be offered to a customer.* Sloane and Christensen teach methods where incentives are selected from among those that have been preloaded into a computer server or database. Deaton describes a method that delivers shopping incentives which are generated by a plurality of independently competing manufacturer controlled dynamic offer engines that customize each incentive to meet manufacturer objectives. Given the discrepancies in the methods for determining the incentives to offer these references teach away from each other by implication and it would not be logical to combine them without the use of impermissible hindsight.

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*References have completely different means of delivering incentives to customers.*

Sloane teaches displaying incentives directly on a wireless device in the store while shopping. Deaton teaches a method that offers custom incentives printed at the register after the purchase is complete, delivered via email some time after the shopping is done, or alternatively printed at a kiosk in the store during the next shopping visit. Christensen teaches loading a computer program onto a personal computer, registering said application by calling an 800 number, providing detailed demographic information, searching the application for any coupons of interest, and then printing any coupons found. Given the discrepancies in the methods for delivering incentives these references teach away from each other by implication and it would not be logical to combine them without the use of impermissible hindsight.

*References have dramatically different descriptions regarding integration with traditional Point of Sale systems.* Deaton teaches a method that is very tightly integrated with the traditional existing store POS system with a cash register and scanner at the end of a check out isle. As the Deaton method depends on data collected at the point of purchase and not during the shopping process it requires this tightly integrated configuration. Sloane, on the other hand, describes a method that is designed to replace the traditional POS system seen today and instead teaches a method with consumer self directed checkout that maintains a running total of purchases as a customer shops throughout the store. Christensen does not integrate with the POS system but instead prints a coupon at home and allows the POS system to remain largely intact. However, given the household identifying ID, it is apparent that Christensen would require additional hardware, software, or both to be installed at all coupon clearing houses to make the scanning and sorting of their target coupons possible. Given the discrepancies in utilization of traditional POS systems versus cart focused consumer directed checkout these references teach away from each other by implication.

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Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious and it would not be logical to combine them without the use of impermissible hindsight.

**Even if Deaton, Sloane, and Christensen were to be combined in the manner proposed, the proposed combination would not show all of the novel features of Claim 9.**

Even if the combination of Deaton, Sloane, and Christensen were legally justified, Claim 9 would still have novel and unobvious features over the proposed combination. In other words applicant's invention as defined by Claim 9 comprises much more than starting with Deaton, adding the wireless scanning device as described in Sloane, and further adding the household ID as described by Christensen. Those features, more fully described in Claim 9, include a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**These novel features of Claim 9 produce new and unexpected results and hence are unobvious and patentable over these references.**

Also applicant submits that the novel features of claim 9 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton and Christensen.

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The new and unexpected results, more fully described in claim 9, include a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane And Christensen.**

The novel features of claim 9 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Christensen without the use of impermissible hindsight.

**Dependent Claims 10-13, 15 And 16 Are A Fortiori Patentable Over Deaton, In View Of Sloane, And Further In View Of Christensen**

The last O.A. rejected dependent claims 10-13, 15, and 16 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211), and further in view of Christensen (U.S. Patent No. 5,710,886). Original dependent claims 10-13, 15, and 16 incorporate all the subject matter of claim 9 and add additional subject matter, which makes them a fortiori and independently patentable over these references.

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**The Rejection Of Dependent Claim 14 In View Of Deaton In View Of Sloane In View of Christensen And Further In View Of Anttilla Is Overcome**

The last O.A. rejected dependent Claim 14 on the combined teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211), in view of Christensen (U.S. Patent No. 5,710,886) and further in view of Anttilla (U.S. Patent No. 6,862,575). Applicant requests reconsideration and allowance over this rejection for the following reasons:

8. Claim 9 already overcomes Deaton, Sloane, and Christensen
9. There is explicit teaching away from such combination
10. There is no suggestion to combine these references.
11. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
12. The references themselves teach away by implication from the suggested combination.
13. Even if the references were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 14.
14. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Anttilla.

**Claim 9 Already Overcomes Deaton, Sloane, And Christensen**

Applicant submits that as claim 9 already overcomes Deaton, Sloane, and Christensen the addition of a wireless device as generating a bar code to be scanned by a point of sale, as suggested by Anttilla, brings forth the same arguments made above against combining references.



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**There Is Explicit Teaching Away From Such Combination**

Sloane explicitly teaches away from combining or integrating with any method that distributes coupons with certain key attributes. As explained in Sloane:

"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the method for dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic system, accurately describe those found in Deaton's. Sloane describes its method to be superior and inherently incompatible with one such as that described by Deaton.

Because Christensen describes a method that hinges on printing coupons from a home computer it is reasonable to imagine that someone considering the dynamic bar code

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rendering patent Anttilla would see these two patents strongly teaching away from each other.

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination without the benefit of impermissible hindsight.

**There Is No Suggestion To Combine These References**

As noted above, there is ample case law that discusses impermissible hindsight vision afforded by the claimed invention.

In the present case, there is no reason given in the last O.A. to support the proposed combination. The original dependent claim 14 incorporates all the subject matter of claim 9 and adds additional subject matter. Applicant submits that since claim 9 overcomes Deaton, Sloane, and Christensen claim 14 is already a fortiori and independently patentable over Deaton in view of Sloane, in view of Christensen, and further in view of Anttilla. That all noted references teach varied methods for providing a discount offer is not sufficient to gratuitously and selectively substitute parts of one reference for parts of other references in order to meet applicant's novel claimed combination, as exemplified starting with Sloane's wireless scanner, by adding Deaton's definition of independently competing manufacturer controlled dynamic offer engines, by then adding the household ID printed on the Christensen coupons, and finally adding Anttilla's scannable bar code display. This impossible combination exemplifies impermissible hindsight by taking the minutest of attributes from varied and incompatible prior art patents and artificially asserting that one could force them together. There is no suggestion in these references that would lead one of having ordinary skill in the art would think to put them together.

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**References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.**

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Sloane, Deaton and Christensen already teach strongly away from each other (as noted above). The addition of the feature from Anttilla does not overcome the teaching away of Sloane and Deaton and further teaches away from addition to Sloane. The integration of Deaton and Sloane as suggested by the O.A., would eliminate the traditional POS system as described in Deaton and instead would create a method with an integrated hand held wireless customer self actuated POS system. It would be even more illogical to add Christensen to that whereby the consumer searches for patents loaded on his or her pc and prints them. It would then be additionally illogical to add a scannable barcode display to the wireless device of this resultant method since there would be no traditional POS system to scan the barcodes on said display. This lack of logical combination additionally teaches away from such a combination.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious and would only make sense with the benefit of impermissible hindsight vision afforded by the claimed invention.

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**Even if Deaton, Sloane, Christensen, And Anttilla Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 14**

Even if the combination of Deaton, Sloane, Christensen, and Anttilla were legally justified, claim 14 incorporating all the subject matter of claim 9 would still have novel (and unobvious) features over the proposed combination. In other words, applicant's invention as defined by Claim 14 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane, then adding the household ID from Christensen, and then adding a scannable bar code display from Anttilla.

The new and unexpected results, more fully described in Claim 9, include a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**These Novel Features Of Claim 14 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.**

Also applicant submits that the novel features of claim 14 incorporating all the subject matter of claim 9 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton, and Anttilla.

The new and unexpected results, more fully described in Claim 9, include a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a

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plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

**It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane, Christensen, And Anttilla.**

The novel features of claim 14 incorporate all the subject matter of claim 9 produce new and unexpected results, as described above, and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, Christensen, and Anttilla and would have only make sense with the benefit of impermissible hindsight vision afforded by the claimed invention.

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**Conclusion**

In view of the above it is submitted that the claims are in condition for allowance.  
Reconsideration and allowance of the objections is respectfully requested.

**Conditional Request For Constructive Assistance**

Applicant has amended the claims of this specification so that they are proper, definite, and define a novel system and method, which is also unobvious. If for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,  
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